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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/007,393	10/26/2001	Joel S. Hochman	Athena1	9804

30596 7590 08/14/2008

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EXAMINER	
HOEKSTRA, JEFFREY GERBEN	
ART UNIT	PAPER NUMBER
3736	

MAIL DATE	DELIVERY MODE
08/14/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/007,393	HOCHMAN ET AL.	
	Examiner	Art Unit	
	JEFFREY G. HOEKSTRA	3736	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12 May 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,12,13,20-47 and 73-87* is/are pending in the application.

4a) Of the above claim(s) *1,12,13,20-31,38-40,44,45 and 80-87* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *32-37,41-43,46,47 and 73-79* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *08 October 2007* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Notice of Amendment

1. In response to the amendment filed on 05/12/2008, amended claim(s) 32, canceled claim(s) 2-11, 14-19, and 48-72, withdrawn claim(s) 1,12, 13, 20-31, 38-40, 44, and 45, , and new claim(s) 73-87 is/are acknowledged. The current rejections of the claim(s) 32-37, 41-43, 46, and 47 is/are *withdrawn*. The following new and reiterated grounds of rejection are set forth:

Election/Restrictions

2. Claims 80-87 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention (i.e. Group III set forth in the Requirement for Restriction/Election mailed 12/20/07), there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 01/21/2008.

3. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 32-37, 41-43, 46, 47, and 73-79 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hochman (US 4,515,167) in view of Guice et al. (US 2002/0010390 A1, hereinafter Guice).

7. For claim 32, Hochman discloses a system for stimulating pelvic muscles and nerves in a human vagina (Abstract), comprising:

- a portable probe unit (10), comprising:
    - a substantially cylindrical body (as best seen in Figure 1);
    - a substantially smooth (as best seen in Figure 1) and substantially sealed outer surface (column 3 lines 10-15, column 4 lines 44-56, and column 6 lines 6-22) with a rounded end (as best seen in Figure 1);

- dimensioning to permit comfortable and repeated insertion into, removal from, and containment entirely within the human vagina (Abstract, column 1 lines 37-63, and column 5 lines 55-66) (as best seen in Figure 1);
- a substantially annular means (11 or 12) substantially flush with the outer surface of the body of the probe unit (as best seen in Figure 1), wherein said annular means is adapted to deliver electrical pulses (column 5 line 47 – column 6 line 22);
- a programmable microprocessor (20) (column 1 lines 63-67, and column 2 lines 18-27) (as best seen in Figure 6);
- a memory (column 1 lines 64-68, column 2 lines 18-27, column 3 lines 4-22, and column 7 lines 28-49);
- a battery (column 2 line 58 – column 3 line 3); and
- a two-way communication means (21) with antenna (22) that transmits and receives signals to and from a controller unit (33) wirelessly and is capable of communicating in real time (column 3 lines 26-63, column 4 line 66 – column 5 line 27, column 6 lines 57-68, and column 8 line 63 – column 9 line 21) (as best seen in Figure 5); and

- the controller unit (33) comprising two-way communication means adapted to both receive signals from said probe unit and transmit signals to said probe unit (column 3 lines 26-63, column 4 line 66 – column 5 line 27, column 6 lines 57-68, and column 8 line 63 – column 9 line 21) wirelessly and is capable of communicating in real time (as best seen in Figures 4-6), wherein said signals

comprise instructions to start, stop, and/or alter the activity of the annular means of the probe unit (column 3 lines 26-63, column 4 line 66 – column 5 line 27, column 6 lines 57-68, and column 8 line 63 – column 9 line 21) (as best seen in Figure 5).

8. For claim 33, Hochman discloses the system, wherein said probe unit further comprises a means for transmitting signals (column 3 lines 26-63, column 4 line 66 – column 5 line 27, column 6 lines 57-68, and column 8 line 63 – column 9 line 21) to an external device (27) in real time (as best seen in Figures 4-6).

9. For claim 34, Hochman discloses the system, wherein said controller unit is capable of being provided with memory (column 3 lines 26-63, column 4 line 66 – column 5 line 27, column 6 lines 57-68, and column 8 line 63 – column 9 line 21).

10. For claim 35, Hochman discloses the system, wherein said probe unit is adapted to be programmed to start and for stop delivery of electrical pulses after a predetermined period of time (column 1 lines 37-56, column 2 lines 18-27, and column 7 lines 1-27) (as best seen in Figure 2).

11. For claim 36, Hochman discloses the system, wherein said probe unit is adapted to be programmed to deliver cycles of alternating electrical pulses and rest periods (column 1 lines 37-56, column 2 lines 18-27, and column 7 lines 1-27) (as best seen in Figure 2).

12. For claim 37, Hochman discloses the system, wherein said probe unit is adapted to be programmed to deliver electrical pulses of varying strengths (column 1 lines 37-56, column 2 lines 18-27, and column 7 lines 1-27) (as best seen in Figure 2).

13. For claim 41, Hochman discloses the system, said probe unit further comprising means for facilitating removal (14) of the probe from a mammal's vagina (as best seen in Figure 1) (column 5 lines 57-62).

14. For claim 42, Hochman discloses the system, wherein said probe unit is less than one inch in diameter and less than four inches in length (column 2 lines 65-67 and column 5 lines 57-62).

15. For claim 43, Hochman discloses the system, wherein said probe unit and said controller unit are capable of being held together and wherein separation of said probe unit and said controller unit is capable of causing said probe unit to turn on.

16. For claim 46, Hochman discloses the system, wherein said controller unit is capable of being to be hand-held.

17. For claim 47, Hochman discloses the system, wherein said controller unit is adapted to permit manual operation and control of said probe unit column 3 lines 26-63, column 4 line 66 – column 5 line 27, column 6 lines 57-68, and column 8 line 63 – column 9 line 21).

18. For claims 32-37, 41-43, 46, 47, and 73-79, Hochman discloses the claimed invention as set forth above except for expressly disclosing the following:

- for claim 32, the controller unit comprising two-way communication means adapted to both receive signals from said probe unit and transmit signals to said probe unit wirelessly and in real-time, wherein said signals to said probe unit comprise control

and programming signals to start, stop, and/or alter the activity of the annular means of the probe unit;

- for claim 73, wherein said two-way communication means of said controller unit is adapted to both receive signals from said probe unit and transmit signals to said probe unit includes means for wirelessly altering operation settings of said probe in real time;
- for claim 74, wherein said means of said controller unit for wirelessly altering integrates a battery, transceiver, antenna, memory and a microprocessor;
- for claim 75, wherein said probe unit contains no surface controls;
- for claim 76, wherein said microprocessor, said memory, said battery, and said two-way communication means with antenna are integrated in said probe unit;
- for claim 77, wherein said controller unit also includes, integrated with said two-way communication means, a programmable microprocessor, battery and antenna, wherein an interactive or closed wireless signal feedback loop is provided within said probe unit and between said controller unit and said probe unit in real time during operation of said system;
- for claim 78., wherein said microprocessor of said probe unit is a programmable microprocessor; and
- for claim 79, wherein said two-way communication means of said probe unit and said controller unit are in the form of transceivers.

19. Guice teaches a system for monitoring a mammalian vagina, comprising *inter alia*:

- for claim 32, a controller unit (50) comprising two-way communication means adapted to both receive signals from said probe unit and transmit signals to said probe unit wirelessly and in real-time, wherein said signals to said probe unit comprise control and programming signals to start, stop, and/or alter the activity of the annular means of the probe unit (paragraphs 42, 100-101, 104-16, 121-139, 179, and 215) (as best seen in Figures 3, 8, 12, and 17-19);
- for claim 73, wherein said two-way communication means of said controller unit is adapted to both receive signals from said probe unit and transmit signals to said probe unit includes means for wirelessly altering operation settings of said probe in real time (paragraphs 42, 100-101, 104-16, 121-139, 179, and 215) (as best seen in Figures 3, 8, 12, and 17-19);
- for claim 74, wherein said means of said controller unit for wirelessly altering integrates a battery, transceiver, antenna, memory and a microprocessor (paragraphs 42, 100-101, 104-16, 121-139, 179, and 215) (as best seen in Figures 3, 8, 12, and 17-19);
- for claim 75, wherein said probe unit contains no surface controls (paragraphs 42, 100-101, 104-16, 121-139, 179, and 215) (as best seen in Figures 3, 8, 12, and 17-19);
- for claim 76, wherein said microprocessor, said memory, said battery, and said two-way communication means with antenna are integrated in said probe unit

(paragraphs 42, 100-101, 104-16, 121-139, 179, and 215) (as best seen in Figures 3, 8, 12, and 17-19);

- for claim 77, wherein said controller unit also includes, integrated with said two-way communication means, a programmable microprocessor, battery and antenna, wherein an interactive or closed wireless signal feedback loop is provided within said probe unit and between said controller unit and said probe unit in real time during operation of said system (paragraphs 42, 100-101, 104-16, 121-139, 179, and 215) (as best seen in Figures 3, 8, 12, and 17-19);
- for claim 78., wherein said microprocessor of said probe unit is a programmable microprocessor (paragraphs 42, 100-101, 104-16, 121-139, 179, and 215) (as best seen in Figures 3, 8, 12, and 17-19); and
- for claim 79, wherein said two-way communication means of said probe unit and said controller unit are in the form of transceivers (paragraphs 42, 100-101, 104-16, 121-139, 179, and 215) (as best seen in Figures 3, 8, 12, and 17-19).

20. For claims 32-37, 41-43, 46, 47, and 73-79, the claimed invention would have been obvious because the substitution of one known element for another would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

21. Because both Hochman and Guice teach communication means within an intravaginally contained probe or transceiver, it would have been obvious to one skilled in the art at the time of the invention to substitute one communication means within an intravaginally contained probe or transceiver for the other to achieve the predictable

results of providing an intravaginally contained probe or transceiver incorporating wireless, real-time, two-way communications of bodily conditions having real-time remote control and programming.

Response to Arguments

22. Applicant's arguments with respect to claims 32-37, 41-43, 46, 47, and 73-79 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

23. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JEFFREY G. HOEKSTRA whose telephone number is (571)272-7232. The examiner can normally be reached on Monday through Friday 8am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on (571)272-4726. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jeffrey G Hoekstra/
Examiner, Art Unit 3736

/Max Hindenburg/
Supervisory Patent Examiner, Art Unit 3736